

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA J. BOLLE

Appeal No. 2004-2007
Application No. 10/014,838

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an external gauge for liquor inventory control in bottles having varying cross-sectional areas along their height. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced in an appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Carr	765,611	Jul. 19, 1904
Hornig	1,235,801	Aug. 7, 1917
Marcussen	1,515,398	Nov. 11, 1924
McDermott	1,589,651	Jun. 22, 1926

The following rejections stand under 35 U.S.C. § 103(a):

- (1) Claims 1, 4, 5 and 8 on the basis of Carr in view of Marcussen.
- (2) Claims 2 and 6 on the basis of Carr in view of Marcussen and Hornig.
- (3) Claims 3 and 7 on the basis of Carr in view of Marcussen and McDermott.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Answer (Paper No. 14) and the final rejection (Paper No. 8) for the examiner's reasoning in support of the rejections, and to the Brief (Paper No. 13) for the appellant's arguments thereagainst.

OPINION

¹ The final rejections of claims 2, 3, 6, and 7 apparently inadvertently were not included in the statement of the rejections in the Answer, although they appear in the final rejection (Paper No. 8).

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The objective of the appellant's invention is to provide a gauge for indicating the amount of liquid remaining in a bottle that has a distinctive shape wherein the cross-section varies along its height. Claim 1 recites a gauge having an edge shaped to match the corresponding external surface of a bottle in a direction parallel to the bottle axis and extending from the outside bottom of the bottle, and a scale extending along the shaped edge and having scale spacing changing as a function of the change in cross-sectional area of the bottle interior in the direction of the bottle axis, with the scale beginning or ending measurement with the bottom of the bottle interior.

The examiner has rejected this claim under 35 U.S.C. § 103(a) as being obvious² in view of the combined teachings of Carr and Marcussen. In arriving at this conclusion, the examiner has found all of the subject matter recited in the claim to be

² The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. §103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985).

disclosed or taught by Carr, except for the gauge body having a bottom that corresponds with the bottom of the bottle, and the edge of the device being shaped the same as the bottle with a corresponding scale to determine the amount of liquid in a specially shaped bottle (Answer, page 4). However, it is the examiner's view that it would have been obvious to one of ordinary skill in the art to modify the Carr scale in such a manner as to meet the terms of the claim in view of the teachings of Marcussen. The appellant advances several arguments in opposition to this conclusion, and we find ourselves in agreement with the appellant that the rejection should not be sustained. Our reasoning follows.

Carr discloses a device comprising a pair of standards (6 and 7), each of which is graduated into a scale for measuring the amount of liquid present in "standard bottles of different sizes" (page 1, lines 53 and 54). It would appear from the disclosure that "standard" bottles are intended to be bottles having straight parallel vertical sides and a cross-section that is constant over essentially the entire height of the bottle that is to be filled with liquid, and that bottles of various heights can be accommodated between the standards. It also is clear from the disclosure that the spacing of the scale does not change, which in our view would indicate to one of ordinary skill in the art that the cross-sectional area of the bottle will remain the same over the height to be filled (see Figure 2). Thus, Carr does not disclose a gauge that can accurately reflect the amount of liquid remaining in a bottle having a cross-sectional area that varies along the height

over which it is filled with liquid, nor is there a recognition in Carr of the problem to which the appellant's invention is directed.

Marcussen discloses a gauge for measuring the amount of cream in milk bottles. At the time of the Marcussen invention (1924), milk was not homogenized, and therefore the cream contained therein, which was of lesser density than the milk, would collect in the uppermost portion of the bottle, above the level of the milk (page 1, column 1). The portion of the disclosed bottle in which the cream collects is of varying cross-sectional area, and Marcussen discloses a gauge having an edge corresponding to the curvature of this portion of the bottle. With the zero mark of the gauge at the level of the top of the filled portion of the bottle, the gauge scale indicates to the user the percent of the volume of the bottle that is filled with cream. The spacing of the scale varies as a function of the cross-sectional area of the bottle (Figure 1). However, the scale extends downwardly over only the upper portion of the bottle, "which range sufficiently serves for any grade of commercial milk that might be found upon the market" (page 1, lines 85-87).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so.³ In the present case, we fail to perceive any teaching, suggestion or incentive in either Carr or Marcussen which would have led one of ordinary skill in the art to modify the Carr

³In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

device in the manner proposed by the examiner, for to do so would require a wholesale reconstruction thereof, which in our view would destroy the invention for, at the very least, it no longer would be able to accommodate the “standard bottles of different sizes” for which it was conceived. In addition, Marcussen’s scale measures from the top of the bottle along only that portion of the bottle where the cross-sectional area changes, whereas Carr provides a scale that measures along the entire length of the filled portion of the bottle, beginning at the bottom. From our perspective, suggestion for making the modifications proposed to the Carr device is found only in the luxury of the hindsight afforded one who first viewed the appellant’s disclosure which, of course, is not a proper basis for a rejection under Section 103.⁴

It therefore is our opinion that the combined teachings of Carr and Marcussen fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1, and we will not sustain the rejection of claim 1 or, it follows, of claim 4, which depends therefrom.

Independent claim 5 contains the same limitations as claim 1, and thus the like rejection of claim 5 also cannot be sustained, along with that of dependent claim 8.

The addition of Hornig to Carr and Marcussen in the rejection of dependent claims 2 and 6, and of McDermott in the rejection of dependent claims 3 and 7, fail to overcome the deficiency pointed out in combining Carr and Marcussen in the rejection

⁴In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

of independent claims 1 and 5. The rejections of claims 2, 3, 6, and 7 therefore also are not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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